

THE HONORABLE RICARDO S. MARTINEZ

THE HONORABLE THERESA L. FRICKE

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

UTHERVERSE GAMING LLC,

Plaintiff,

v.

EPIC GAMES, INC.,

Defendant.

Case No. 2:21-cv-00799-RSM-TLF

**JOINT STIPULATED MOTION FOR
ENTRY OF JUDGMENT OF NON-
INFRINGEMENT OF U.S. PATENT
NOS. 8,812,954 AND 9,123,157 AND
DISMISSAL WITHOUT PREJUDICE
OF RELATED AFFIRMATIVE
DEFENSES AND
COUNTERCLAIMS; AND ORDER**

NOTE ON MOTION CALENDAR:

FEBRUARY 16, 2023

1 Plaintiff Utherverse Gaming LLC (“Utherverse Gaming”) and Defendant Epic Games Inc.
 2 (“Epic”) (collectively, the “Parties”), by and through their undersigned counsel, hereby jointly
 3 move for entry of judgment of non-infringement of U.S. patent numbers 8,812,954 (the “’954
 4 Patent”) and 9,123,157 (the “’157 Patent”) and for dismissal without prejudice of related
 5 affirmative defenses and counterclaims pursuant to the following stipulation:

6 **WHEREAS**, on June 11, 2021, Utherverse Gaming filed its Complaint for Patent
 7 Infringement of U.S. patent number 8,276,071 (the “’071 Patent”), the ’954 Patent, the ’157 Patent,
 8 and U.S. patent number 9,724,605 (the “’605 Patent”) (collectively, the “Asserted Patents”) (ECF
 9 No. 1);

10 **WHEREAS**, Epic asserted various affirmative defenses and counterclaims on January 18,
 11 2022, in its Answer to Complaint for Patent Infringement and Counterclaims (ECF No. 58),
 12 including its Third and Fourth Affirmative Defense of invalidity and non-infringement of the ’954
 13 Patent; its Fifth and Sixth Affirmative Defense of invalidity and non-infringement of the ’157
 14 Patent; its Third and Fourth Counterclaim for non-infringement and invalidity of the ’954 Patent;
 15 and its Fifth and Sixth Counterclaim for non-infringement and invalidity if the ’157 Patent
 16 (collectively, the “’954 Patent and ’157 Patent Affirmative Defenses and Counterclaims”);

17 **WHEREAS**, Utherverse Gaming served its Disclosure of Asserted Claims and
 18 Infringement Contentions on November 2, 2021 (the “Infringement Contentions”) in which it
 19 identified the asserted claims of the ’954 Patent as claims 3, 4, 9, 10, 14, 16, 17, 18, 19, and 27
 20 and the asserted claims of the ’157 Patent as claims 1, 2, 8, 10, 11, 12, 13, 21, and 26 (the “Asserted
 21 Claims”);

22 **WHEREAS**, the Court issued a claim construction order on October 20, 2022 and an order
 23 denying Utherverse Gaming’s motion for reconsideration of the claim construction order on
 24 November 15, 2022 (ECF Nos. 133, 146) (the “Claim Construction Orders”), after consideration
 25 of the Parties’ related briefings (ECF Nos. 63, 72, 73, 75, 76, 81, 82, 83, 84, 137, 145) and oral
 26 arguments held on August 16, 2022 (*see* ECF No. 111);

1 **WHEREAS**, in the Claim Construction Orders, the Court construed the term “multi-
2 dimensional avatar” to mean “an avatar that has a multi-instance presence in more than one
3 dimension” (ECF Nos. 133 at p. 12);

4 **WHEREAS**, the Parties now agree by way of stipulation to move for entry of judgment of
5 non-infringement of all the Asserted Claims of the '954 Patent and the '157 Patent with respect to
6 the products and configurations as specifically identified in the Infringement Contentions (the
7 “Accused Products”) based on the Court’s construction of “multi-dimensional avatar”; and

8 **WHEREAS**, Utherville Gaming expressly indicates its intent to appeal the Court’s
9 construction of at least “multi-dimensional avatar” (ECF Nos. 133, 146) following entry of a final
10 judgment.

11 **THEREFORE**, and subject to the approval of the Court and Utherville Gaming’s rights
12 to appeal at least the construction of “multi-dimensional avatar” following an entry of final
13 judgment, the parties **HEREBY STIPULATE AND AGREE** as follows:

14 1. In light of the Court’s Claim Construction Orders (ECF Nos. 133, 146), the
15 Accused Products have not infringed and currently do not infringe the Asserted Claims of the '954
16 Patent and the '157 Patent because the Accused Products do not include “multi-dimensional
17 avatars” (as presently construed); the Accused Products thus do not meet the “multi-dimensional
18 avatar” limitation contained in the Asserted Claims of the '954 Patent and '157 Patent;

19 2. Utherville Gaming and Epic, therefore, stipulate to entry of judgment that the
20 Accused Products have not infringed and currently do not infringe the Asserted Claims of the '954
21 Patent and the '157 Patent under the Court’s construction of “multi-dimensional avatar.” (ECF
22 Nos. 133, 146);

23 3. Utherville Gaming and Epic stipulate to the dismissal *without prejudice* of the
24 '954 Patent and '157 Patent Affirmative Defenses and Counterclaims and Utherville Gaming’s
25 first affirmative defense as it pertains to and only to the '954 Patent and the '157 Patent subject to
26 Utherville Gaming and Epic’s right to revive any such affirmative defenses and counterclaims, in

1 the event of a remand from the United States Court of Appeals for the Federal Circuit;

2 4. The Parties reserve their right to challenge the construction of not only “multi-
3 dimensional avatar” but any other construction of the disputed claim terms on appeal. Utherverse
4 Gaming and Epic reserve all appellate rights arising from this action, expressly including the right
5 to appeal the Court’s Claim Construction Orders to the United States Court of Appeals for the
6 Federal Circuit.

7 5. Should the Court’s Claim Construction Orders be altered on appeal or during the
8 underlying district court litigation, nothing herein shall be deemed an admission by Utherverse
9 Gaming or Epic.

10 6. The foregoing stipulation serves only as a judgment of non-infringement as it
11 pertains to the ’954 Patent and ’157 Patent and not a final judgment to the action in its entirety.

1 DATED this 16th day of February, 2023

Respectfully submitted,

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DATED this 16th day of February, 2023

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EPIC GAMES, INC.

ORDER

**PURSUANT TO THE FOREGOING STIPULATION, IT IS ORDERED, ADJUDGED,
AND DECREED THAT:**

1. Judgment of Non-Infringement of U.S. patent numbers 8,812,954 (the “’954 Patent”) and 9,123,157 (the “’157 Patent”) is entered for Defendant Epic Games, Inc. given the Court’s construction of “multi-dimensional avatar.”

2. The ’954 Patent and ’157 Patent Affirmative Defenses and Counterclaims and Utherverse Gaming’s first affirmative defense as it pertains to and only to the ’954 Patent and the ’157 Patent are DISMISSED WITHOUT PREJUDICE.

3. This order serves only as a judgment on claims of non-infringement for the ’954 Patent and the ’157 Patent. This order does not serve as a final judgment for the entirety of the action whereby the time to appeal otherwise runs.

DATED this 20th day of April, 2023.



HON. RICARDO S. MARTINEZ
UNITED STATES DISTRICT JUDGE

Presented By:

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CERTIFICATE OF SERVICE

I hereby certify under penalty of perjury under the laws of the State of Washington that on the date below, I electronically filed the foregoing Joint Stipulation for Entry of Final Judgment of Non-Infringement of U.S. Patent Nos. 8,812,954 and 9,123,157 and Proposed Order with the Clerk of the Court using the CM/ECF system, which will send electronic notification of such filing to the attorneys of record in this case.

DATED this 16th day of February at Seattle, Washington.

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